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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,292	11/20/2001	Takashi Yamaguchi	F-7230	9540

28107 7590 10/19/2004  
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EXAMINER

RADA, ALEX P

ART UNIT PAPER NUMBER

3714

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/989,292	YAMAGUCHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alex P. Rada	3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Election/Restriction*

In response to the election/restriction filed June 9, 2004 in which the applicant's elect group I, claims 1-5 and 11 which are pending in this office action.

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-5 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in tow-prong test of:

- (1) Whether the invention is within the technological arts; and
- (2) Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the claimed invention is believed to be within the technological arts.

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. [*“Usefulness’ may be evidenced by, but not limited to , a specific utility of the claimed invention. “Concreteness” may be evidenced by, but not limited to, repeatability and/ or implementation without undue experimentation. “Tangibility “may be evidenced by, but not limited to, to a real or actual effect.”*]

In the present case, claims 1 and 11 only recite an abstract idea. The recited system merely obtains information from an input device, an estimation creating device for creating estimation of the setting information obtained by the information obtaining device, referring to a database in which the setting information and information for estimating the setting state are stored correspondingly with each other, and an estimation transmission device for transmitting the created estimation to a predetermined destination through the network, which is just a manipulating the data.

To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in i) below), or (B) be limited to a practical application within the technological arts (MPEP 2106 (IV)(B)(2)(b).

In the present case, claim 11 only recites a program. A computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program’s functionality, as nonstatutory functional descriptive material (MPEP 2106 (IV)(B)(1)(a).

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-5 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not show how one of ordinary skill in the art could provide the information obtaining device for receiving setting information corresponding to a setting state of the parameters from a predetermined user terminal through a network, an estimation creating device for creating estimation of the setting information obtained by the information obtaining device, referring to a database in which the setting information and information for estimating the setting state are stored correspondingly with each other, and an estimation transmission device for transmitting the created estimation to a predetermined destination through the network as recited in claims 1 and 11. The examiner request that applicant point out in the disclosure the claimed subject matter.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another

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who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims I-II and 5 are rejected as best understood under 35 U.S.C. 102(e) as being anticipated by DeAngelis et al. (US 6,247,994).

7. DeAngelis et al discloses the following:

An information obtaining device for receiving setting information corresponding to a setting state of the parameters from a predetermined user terminal through a network (controllers 42a-42d), an estimation creating device for creating estimation of the setting information obtained by the information obtaining device (within central station 64), referring to a database in which the setting information and information for estimating the setting state are stored correspondingly with each other, and an estimation transmission device for transmitting the created estimation to a predetermined destination through the network (within central station 64 and column 21, lines 41-65) as recited in claims I and II.

The toy system presents the information for specifying the user's setting state of a plurality of parameters to the user, in which the examiner interprets the

buttons on the controllers 42a-42b to be the user's setting state, and the information obtaining device (within central station 64) obtains the information presented to the user by the toy system, from the user terminal, as the setting information as recited in claim 2.

A driving machine (12, 14, 16, and 17 in figure 1) and a transmission unit for a user's remote-controlling of the driving machine (421042b), and the settable parameters are to affect a correspondence between an input operation of the transmission unit and a control amount of the driving machine based on a control signal transmitted from the transmission unit to the driving machine (column 2, lines 38-67) as recited in claim 3.

The information of sentences expressing characteristic of the setting state specified in the setting information and/or information of sentences for giving a clue to improvement of the setting state to a user is stored in the database as the information for estimating (within central station 64) as recited in claim 4.

The estimation transmission device transmits to the user terminal, through the network, the information for presenting the sentences to a user as at least one part of the estimation information (column 21, lines 41-65) as recited in claim 5.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Barton, Jr. et al. '135, Choi '883, Del Castillo et al. '714, Nakada et al. '901, Pelekis '844, Dratman '927, Fainmesser et al. '436, Gabai et al. '344 and Higashida '873 all disclose different types of systems for communicating with, controlling, and programming of operated toy objects.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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